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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,857	10/29/2003	Mark Robert Fisher	6524	5706

7590

07/26/2005

Appleton Papers Inc.
825 E. Wisconsin Avenue
P.O. Box 359
Appleton, WI 54912-0359

EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/694,857	FISHER ET AL.	
	Examiner	Art Unit	
	Bruce H. Hess	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-29-03 (IDS) and 3-26-04 (IDS)
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO-609) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3-26-04 and 10-29-03</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the patents to Midorikama et al. (USP 6,407,036 or USP 6,677,275).

These patents teach thermally responsive record material comprising a support having a color-forming composition provided thereon. This composition can contain bis (4-hydroxy-3-allylphenyl) sulphone and a compound of applicants' formula II. Since 4,4'-sulfonyl bisphenol is a precursor used in the manufacture of bis (4-hydroxy-3-allylphenyl) sulfone, it is inherent that some of the unreacted precursor is present alone with the sulfone product. Topcoats, fluoran color formers, sensitizers and paper supports are additionally disclosed.

It is noted that applicants' specification establishes that unexpected results are obtained with applicants' compounds I and II when compared to several different conventional color developers. However, since these are not among the color developers disclosed by the Midorikama et al. patents, applicants' showings are not dispositive of the issue of patentability.

2. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of the patents to Midorikama et al. in view of the patent to Fujii et al. (USP 6,103,661).

The teachings of the primary references are discussed in the preceding paragraph. Fujii et al. Teach that when applicants' compound of formula II is employed in thermally response record material along with applicants' compound I, the compound of formula II can be employed in layers other than the recording layer. Given this expanded use taught by the secondary reference, use of the primary references'

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compound of formula II in layers other than the recoding layer would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

BHHess
July 21, 2005

A handwritten signature in black ink, appearing to read "B. Hamilton Hess". The signature is written in a cursive, flowing style with a large initial "B" and a stylized "H".

**B. HAMILTON HESS
PRIMARY EXAMINER**